

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

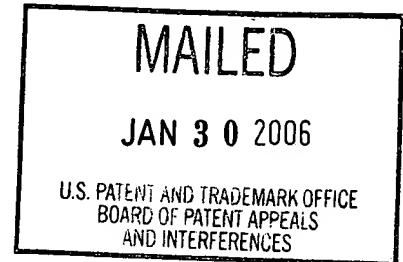
UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE OWEN, Jr.

Appeal No. 2005-1805
Application 09/728,705

ON BRIEF



Before THOMAS, BLANKENSHIP, AND MACDONALD, **Administrative Patent Judges**.
MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-23.

We REVERSE.

Invention

Appellant's invention relates to methods and systems for tracking and balancing accounts receivable data. Appellant's specification at page 7, paragraph [0022].

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of automatically tracking and balancing account receivable data comprising:
 - submitting a billing data file to a processing entity, said billing data file comprising customer account records representing accounts receivable for a given carrier;
 - determining each of said customer account records as one of at least two tracking data sets based on pre-defined criteria;
 - computing a total amount of accounts receivable for said customer account records located in each tracking data set related to said given carrier;
 - generating a total amount of processed accounts receivable related to said given carrier by adding the computed total amounts of accounts receivable of the at least two tracking data sets;
 - comparing a total amount of pre-processed accounts receivable related to said given carrier to the total amount of processed accounts receivable related to said given carrier, the total amount of pre-processed accounts receivable being the total amount of the accounts receivable inputted to the processing entity by said carrier;
 - creating a discrepancy report comprising said carrier if the total amount of pre-processed accounts receivable does not equal the total amount of processed accounts receivables [sic]; and
 - creating a settlement report for said carrier if the total amount of pre-processed accounts receivable equals the total amount of processed accounts receivable.

References

The references relied on by the Examiner are as follows:

Crooks et al. (Crooks)	5,943,656	August 24, 1999
Northington et al. (Northington)	6,128,602	October 3, 2000

Rejections At Issue

Claims 1-23 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Crooks and Northington.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-23 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims stand or fall together. See page 2 of the brief. We will, thereby, consider Appellant's claims, as standing or falling together and we will treat claim 1 as a representative claim of all the claims.

¹ Appellant filed an appeal brief on May 13, 2004. The Examiner mailed an Examiner's Answer on August 26, 2004.

Whether the Rejection of Claims 1-23 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-23. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, we find one and only one of Appellant’s arguments persuasive. The remaining arguments are unpersuasive for essentially the reasons set forth by

the Examiner in the answer. As to the one persuasive argument, Appellant argues at page 3 of the brief, that the comparing step is “to determine if sufficient funds have been collected.” The Examiner replied at page 9 of the answer stating, “the features ... are not recited in the rejected claims(s).”

At first analysis this panel reached the same conclusion as the Examiner. However, upon further review we reach a different conclusion. While we agree that “to determine if sufficient funds have been collected” is not explicitly stated in claim 1, we find that claim 1 does implicitly require for a given carrier a determination of whether the pre-processed accounts receivable (debits) are equal to processed accounts receivable (credits). We base our conclusion on the preamble language of claim 1.

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). However, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

The preamble of claim 1 results in a manipulative difference between the claimed invention and the prior art. Claim 1, line 1, requires “balancing.” The field of the present invention is accounting and in that field the term “balancing” means to compute the difference

between the debits and credits of (an account)” or “to reconcile or equalize the sums of the debits and credits of (an account).”² These definitions place a restriction on claim 1 in that the comparing step requires the pre-processed accounts receivable and processed accounts receivable be related as debits and credits of the same account. Thus, while Crooks’ comparing current billing information to the billing information of a prior period meets the language of the comparing step standing by itself, Crooks’ comparing does not meet the language of the claimed comparing step when looked at in the full context of claim 1.

Independent claim 16 contains identical “balancing” (preamble) and “comparing” (step) limitations as found in claim 1. Thus, the result for claim 16 is the same as above.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

Other Issues

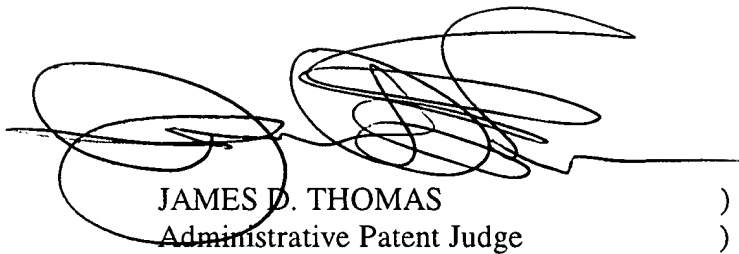
In our review of this appeal we noted the following items. At claim 1, line 18, “receivables” should be singular not plural. In paragraphs [0016]-[0026] of the substitute specification filed on October 17, 2003, the word “pre-processed” is repeatedly misspelled as “pine-processed.” Also, at paragraph [0006] of the substitute specification the word “determine” is misspelled.

Conclusion

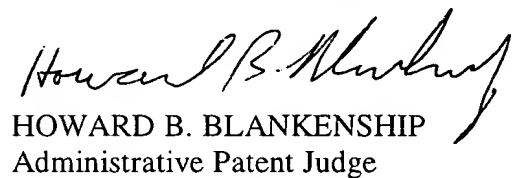
In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-23.

² Webster’s II New Riverside University Dictionary, 1988, page 148. Copy provided to Appellant.

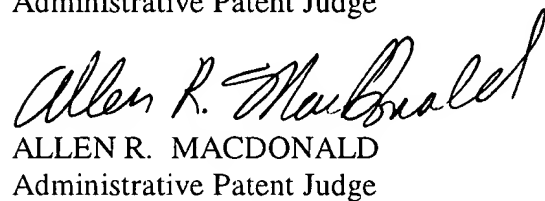
REVERSED



JAMES D. THOMAS
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge



ALLEN R. MACDONALD
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 2005-1805
Application 09/728,705

PHILMORE H. COLBURN II
CANTOR COLBURN LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002